

### REMARKS

Claims 35, 37 and 42 have been amended as well as page 1 of the specification. Applicant is submitting a substitute specification and a Terminal Disclaimer. The claims have been rewritten to place them in better form for examination and to further obviate the 35 U.S.C. §§102, 103 and 112 rejections set forth in the Office Action dated May 3, 2002. It is believed that none of these amendments constitute new matter. Withdrawal of these rejections is requested.

The Examiner has objected to the specification and requested a substitute specification be presented. Applicant has attached the substitute specification which incorporates the changes from the preliminary amendment dated 7/30/01.

The Examiner has rejected claims 35-42 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 35, 37 and 42 to more distinctly claim the subject matter of the present invention. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 35 and 38-40 under 35 U.S.C. §102(e) as being anticipated by Hansen, G. (US 6,162,965) filed June 2, 1997 and issued December 19, 2000. Applicant submits that Hansen does not disclose or suggest using a 19°C temperature for co-cultivation with using *Agrobacterium* 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising amino saccharide. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner has rejected claims 35, 38-40 and 36 under 35 U.S.C. §103(a) as being unpatentable over Hanson, G. (US 6,162,965) filed June 2, 1997, issued December 19, 2000 as applied to claims 35 and 38-40 and further in view of Applicant's admitted prior art.

Further, the Examiner has rejected claim 37 under 35 U.S.C. §103(a) as being unpatentable over Hansen, G. (US 6,162,965) filed June 2, 1997, issued December 19, 2000 in view of Holton (US 5,948,955) issued September 7, 1999, PCT publication date December 8, 1994.

Further, the Examiner has rejected claims 35 and 38-41 under 35 U.S.C. §103(a) as being unpatentable over Hansen, G. (US 6,162,965) filed June 2, 1997, issued December 19, 2000 as applied to claims 35 and 38-40 above, in view of Bhojwani, S.S. et al. (Developments in Crop Science, vol. 5, pp 24-41, 1983).

Applicant submits it is settled law that "elements of separate patents (or publications) cannot be combined when there is no suggestion of such combination anywhere in those patents (or publications) . . .; and a court (or PTO) should avoid hindsight . . ." *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984). See also *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434, 1438-1441 (Fed. Cir. 1988).

In addition, it is well established law that both the suggestion and a reasonable expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Dow Chemical*, 5 USPQ 1529, 1531 (Fed. Cir. 1988). *In re O'Farrell*, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). Applicant submits that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention and that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious. *In re O'Farrell, supra*.

None of the references cited by the Examiner discloses or suggests using a 19°C temperature for co-cultivation with using *Agrobacterium* 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising amino saccharide. Therefore, there is no *prima facie* case of obviousness.

The determination of obviousness cannot be made without consideration of Applicant's invention as a whole. As the Federal Circuit has stated,

. . . at all costs, the mistake of picking random bits of various prior art references and employing them as a "mosaic to recreate a facsimile of the claimed invention" must be avoided.

*W. L. Gore and Assoc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), citations omitted.

Applicant submits that the Examiner has randomly picked bits of prior art references using the hindsight provided by Applicant's disclosure.

A determination of obviousness cannot be made without consideration of the particular problems faced by the inventor. As stated by the Court of Customs and Patent Appeals,

[v]iewed after the event, appellant's invention may appear to be simple and as such obvious to those of ordinary skills in this art. This, however, is not a basis upon which to reject the claims. Where the invention of which a patent is sought solves a problem which persisted in the art, we must look to the problem as well as to its solution if we are to properly appraise what was done and to evaluate it against what would be obvious to one having ordinary skills in the art.

*In re Rothermel and Waddel*, 125 USPQ 328, 332 (CCPA 1960).

In addition, the Federal Circuit has held that a determination of obviousness requires that there be a suggestion in the prior art that would lead a person of ordinary skill to the same solution of the problems facing the applicant. *Stratoflex v. Aeroquip*, 218 USPQ 871 (Fed. Cir. 1983).

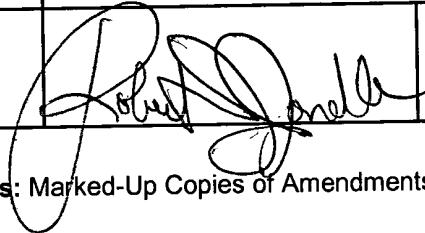
Part of Applicants' invention was understanding the problem.

In view of these facts, it is submitted that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification. As a result it is respectfully submitted that these rejections be withdrawn.

The Examiner has provisionally rejected claims 35-42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-8, 12, 15, 17-21, 29 and 31 of co-pending application 09/203,679. Since the time of writing this Office Action and the time of writing this Amendment, co-pending application 09/203,679 has matured into U. S. Patent 6,420,630 on July 16, 2002. Applicant has amended the Cross Reference section of the patent application and have also attached a signed Terminal Disclaimer. Withdrawal of this rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §§102, 103 and 112 and are not obvious over the prior art. Reconsideration of this application and early notice of allowance is requested.

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED					
NAME AND REG. NUMBER	Robert J. Jondle, Reg. No. 33,915				
SIGNATURE		DATE	October 3, 2002	DEPOSIT ACCOUNT USER ID	

**Attachments:** Marked-Up Copies of Amendments

**MARKED UP COPY OF CHANGES TO SPECIFICATION**

Please Amendmend paragraph [0001] as follows:

[0001] This application is a divisional of U. S. Patent Application having Serial No. 09/203,679 filed December 1, 1998 that has matured into U. S. Patent No. 6,420,630 issued July 16, 2002.

MARKED UP COPY OF AMENDED CLAIMS

35. (AMENDED) A method for transforming a ~~line~~ tissue of corn comprising the steps of:

(a) co-cultivating an immature embryo from said ~~line~~ tissue at a temperature of about 15°C to about 22°C with *Agrobacterium* capable of transferring at least one ~~gene to tissue of said line~~ genetic element to said tissue to produce an infected embryo;

(b) culturing the infected embryo on a medium comprising an antibiotic;

(c) culturing ~~the~~ resulting tissue on a medium comprising a selective agent;

(d) selecting transformed tissue ~~comprising growing~~ having Type II callus;

and

(e) regenerating transgenic plants from said Type II callus.

37. (NEW) A method for transforming a ~~line~~ tissue of corn comprising the steps of:

(a) co-cultivating an immature embryo from said ~~line~~ tissue with *Agrobacterium* capable of transferring at least one ~~gene~~ genetic factor to ~~said~~ tissue of ~~said line~~ to produce an infected embryo, wherein said *Agrobacterium* is taken from *Agrobacterium* about 0.5 to about 5 days after rescue from frozen glycerol stocks;

(b) culturing the infected embryo to initiate callus on a medium comprising an antibiotic;

(c) culturing the resulting callus tissue on a medium comprising a selective agent;

(d) selecting transformed callus tissue ~~comprising growing~~ having Type II callus; and

(e) regenerating transgenic plants from said growing Type II callus.

42. (NEW) A method for transforming a ~~line~~ tissue of corn using *Agrobacterium* comprising the steps of:

- (a) initiating co-cultivation of an immature embryo from said ~~line~~ tissue with *Agrobacterium* capable of transferring at least one ~~gene~~ genetic factor to said tissue ~~of said line~~ to produce an infected embryo;
  - (b) applying heat shock treatment during said co-cultivation;
  - (c) culturing the infected embryo to initiate callus on a medium comprising an antibiotic and glucose;
  - (d) culturing the resulting callus tissue on a medium comprising a selective agent;
  - (e) selecting transformed callus tissue ~~comprising growing~~ having Type II callus;
- and
- (f) regenerating transgenic plants from said Type II callus.